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In re Application of	:	
GODDEN et al.	:	
Application No.: 10/528,442	:	DECISION ON PETITION
PCT No.: PCT/US04/09565	:	UNDER 37 CFR 1.47(a)
Int. Filing: 29 March 2004	:	
Priority Date: 28 March 2003	:	
Attorney Docket No.: 4758-4101US1	:	
For: SYSTEM AND METHOD OF	:	
EMPLOYING INDICIA ON WEB	:	
MATERIAL AND WEB MATERIAL	:	
USING SAME	:	

This decision is issued in response to applicants' "Petition under 37 CFR 1.47(a)" filed 22 November 2005 to accept the application without the signature of joint inventor, Mark Godden. The \$200 petition fee has been submitted.

BACKGROUND

On 29 March 2004, applicants filed international application PCT/US04/09565, which claimed a priority date 28 March 2003. Pursuant to 37 CFR 1.495, the period for paying the basic national fee in the United States expired 30 months from the priority date, 28 September 2005.

On 18 March 2005, applicants filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and the international search report.

On 23 September 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 22 November 2005, applicants filed the present petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1), (3) and (4) have been satisfied.

Regarding item (2) above, Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted.

Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Petitioner states that Mark Godden has refused to execute the application. A review of the present petition and the accompanying papers reveals that applicants have not satisfied item (2) above, in that, the applicants have not shown that a bona fide attempt was made to present the application papers to Mark Godden. Keith McWha states that he mailed a copy of the application papers to Mark Godden on 24 August 2005. A copy of the cover letter has been provided. However, petitioner fails to include evidence to demonstrate that the materials were actually received by the nonsigning inventor at his last known address. Where the Office is being asked to accept the silence of the nonsigning inventor as evidence of a refusal to sign, petitioner must provide some evidence that the application materials have been received by the nonsigning applicant. Additionally, the statements

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made with regards to the efforts to reach Mark Godden, on April 12, 2005 and August 17, 2005, constitutes secondhand knowledge, in that, the actions to which petitioner is averring to were conducted by Maureen Shook. Lastly, it is unclear if petitioner is presenting evidence that Mark Godden is refusing to execute the application or cannot be found or located after diligent effort.

For the above reasons, it would not be appropriate to accept this application without the signature of Mark Godden at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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